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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,385	12/27/2000	Joyo Wijaya	WVANP013	6355
34071	7590	06/15/2006	EXAMINER	
IPVENTURE, INC. 5150 EL CAMINO REAL SUITE A-22 LOS ALTOS, CA 94022			THEIN, MARIA TERESA T	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/750,385	<b>Applicant(s)</b> WIJAYA ET AL.	
	<b>Examiner</b> Marissa Thein	<b>Art Unit</b> 3627	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32,34,35 and 37-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32,34,35 and 37-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3-28-06; 05-19-06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicants' "Amendment D" filed on March 24, 2006 has been considered.

Applicants' response to claim 3 has overcome the Examiner's rejection under 35 USC 112, second paragraph.

Claims 1, 4-6, 10-11, 15-17, 19-20, 23-25, 29-30, and 34. New claims 37-39 have been added. Claim 36 is cancelled. Claims 1-32, 34-35, and 37-39 remain pending in this application.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on March 28, 2006 and May 16, 2006 are being considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-32 and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 2004/0236635 to Publicover in view of U.S. Patent No. 6,463,345 to Peachey-Kountz et al. and in further view of U.S. Patent No. 5,592,378 to Cameron et al.**

Regarding claims 1, 15, 23, Publicover discloses a computer implemented method and program and system for effecting via a computer network (Figure 1; paragraphs 25 and 75), substitutions of at least one ordered item of at least one

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customer order, the method comprising: receiving, via a computer network (paragraphs 75-76) at least one customer order placed by a customer through a computing device (customer places an order online), the at least one customer order including more than one ordered item (one or more items; paragraph 7), the customer order being a current order of the customer, including delivery time information regarding the order (paragraph 75-76); identifying an ordered item in the received customer order relating to an oversold item (paragraph 75); upon identifying the ordered item relating to the oversold item, automatically substituting, based upon information regarding at least one substitution preference stored in a storage medium, at least one substitute item for the identified ordered item in the received customer order, the at least one substitution preference being provided by the customer (paragraphs 75-76); and wherein the customer is allowed to modify the at least one substitution preference during the current order (paragraph 76).

However, Publicover does not explicitly disclose the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory; and analyzing a selected portion of the received customer order taking into consideration at least another customer order to determine whether at least one item of inventory has been oversold, the analyzing being performed prior to the delivery of at least one ordered item of the received customer order and at least one ordered item of the at least another customer order; and the customer is allowed to view the images of the item. Publicover discloses goods in an ordered basket, which are in different product groups within the ordered basket, may arrive at different times (paragraph 77).

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Furthermore, Publicover discloses substitution of an out of stock product may be predetermined or system may be preprogrammed to digitally contact customer with several choices based on a customer profile (paragraph 75). The individual customer may input information detailing their preferences on product substitution in case of unavailability (paragraph 76).

Peachey-Kountz, on the other hand, teaches an ATP (available-to -promise) engine tool and system receives orders from multiple demand sources or ordering systems (abstract). Tool uses can maintain a synergistic relationship between multiple ordering systems (abstract). Peachey-Kountz teaches automatically makes substitutions based on business decisions, rules and in user-defined information (col. 10, lines 4-7). The business rules, which include customer requirements and enterprise, order commitment policies determine solutions without manual intervention (col. 12, lines 26-32). The Peachy-Kountz teaches the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory (col. 4, lines 45-67); and analyzing a selected portion of the received customer order taking into consideration at least another customer order to determine whether at least one item of inventory has been oversold, the analyzing being performed prior to the delivery of at least one ordered item of the received customer order and at least one ordered item of the at least another customer order (col. 3, lines 52-56; col. 3, lines 61-67; col. 5, lines 37-44; col. 7, lines 6-16; col. 10, lines 24-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program and system of

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Publicover, to include the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory; and analyzing a selected portion of the received customer order, as taught by Peachy-Kountz, in order to provide optimized product availability information (Peachy-Kountz, col. 4, lines 11-12).

Cameron, on the other hand, teaches the customer is allowed to view the images of the item (col. 89, lines 36-38; col. 89, lines 60-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program, and system of Publicover to include, the customer is allowed to view the images of the item, as taught by Cameron, in order to display an electronic image depicting a representation of the item (col. 89, lines 60-64).

Claims 2-4, 7-10, 18, 26, Publicover comparing analyzed order data to inventory data to determine whether at least one item of inventory has been oversold (paragraph 75); the comparing occurs before fulfillment of said portion of the received customer order (paragraph 75); the substituting includes selecting desired ordered item corresponding to the oversold item (paragraph 75); the ordered item substitution occurs at a time of fulfillment of the portion of the received customer order (paragraph 75); the ordered item substitution is performed at a time of fulfilling an order without intervention from a human operator (paragraph 9; paragraph 75); the substitution is performed by an automated computer process (paragraph 9; paragraph 75); and automatically substituting also depends on a sorted list of substitute products from which the substitute item is chosen (paragraph 75).

Claims 5-6, 11-14, 16-17, 24-25, 27-28, Publicover substantially discloses the claimed invention, however, it does not explicitly disclose the ratio rule for substituting the substitute item for the identified ordered item; comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon the quantity value associated with each of the identified ordered items; comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon a number related to substitution already implemented in each customer order associated with the identified ordered item; and aggregating a selected portions of the received customer orders to determine whether at least one item of inventory has been oversold. Publicover discloses goods in an ordered basket, which are in different product groups within the ordered basket, may arrive at different times (paragraph 77). Furthermore, Publicover discloses substitution of an out of stock product may be predetermined or system may be preprogrammed to digitally contact customer with several choices based on a customer profile (paragraph 75). The individual customer may input information detailing their preferences on product substitution in case of unavailability (paragraph 76).

Peachy-Kountz, on the other hand, teaches the ratio rule for substituting the substitute item for the identified ordered item (col. 4, lines 45-67); comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon the quantity value associated with each of the identified ordered items (col. 12, line 65 – col. 12, line 8; col. 12, lines 18-25);

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comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon a number related to substitution already implemented in each customer order associated with the identified ordered item (col. 12, line 65 – col. 12, line 8; col. 12, lines 18-25); aggregating a selected portions of the received customer orders to determine whether at least one item of inventory has been oversold (col. 3, lines 52-56; col. 3, lines 61-67; col. 5, lines 37-44; col. 7, lines 6-16; col. 10, lines 24-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program and system of Publicover, to include the ratio rule for substituting the substitute item for the identified ordered item; comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon the quantity value associated with each of the identified ordered items; comparing the identified ordered item with at least another identified ordered item in another customer order related to the oversold item based upon a number related to substitution already implemented in each customer order associated with the identified ordered item; aggregating a selected portions of the received customer orders to determine whether at least one item of inventory has been oversold, as taught by Peachy-Kountz, in order to provide optimized product availability information (Peachy-Kountz, col. 4, lines 11-12).

Regarding claims 19-22 and 29-32, Publicover substantially discloses the claimed invention, including the at least one predefined criterion to determine a first



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preferred substitution item for the identified item (paragraph 75). However, Publicover does not explicitly disclose whether a sufficient quantity of the first preferred substitution item is available to be substituted for the identified item; determining a second preferred substitution item for the identified item in response to a determination that there is an insufficient quantity of the first preferred substitution item available to be substituted for the identified item; partially substituting an ordered item of the identified item; and fully substituting an ordered item for the identified item; and the customer is allowed to view the images of the item. Publicover discloses goods in an ordered basket, which are in different product groups within the ordered basket, may arrive at different times (paragraph 77). Furthermore, Publicover discloses substitution of an out of stock product may be predetermined or system may be preprogrammed to digitally contact customer with several choices based on a customer profile (paragraph 75). The individual customer may input information detailing their preferences on product substitution in case of unavailability (paragraph 76).

Peachy-Kountz, on the other hand, teaches whether a sufficient quantity of the first preferred substitution item is available to be substituted for the identified item; determining a second preferred substitution item for the identified item in response to a determination that there is an insufficient quantity of the first preferred substitution item available to be substituted for the identified item; partially substituting an ordered item of the identified item; and fully substituting an ordered item for the identified item (col. 4, lines 45-67; col. 5, line 66 – col. 6, line 3; col. 10, lines 3-15; col. 10, lines 40-52; col. 12, line 65 – col. 13, line 2; col. 13, lines 11-13).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program and system of Publicover, to include a sufficient quantity of the first preferred substitution item is available to be substituted for the identified item; determining a second preferred substitution item for the identified item in response to a determination that there is an insufficient quantity of the first preferred substitution item available to be substituted for the identified item; partially substituting an ordered item of the identified item; and fully substituting an ordered item for the identified item, as taught by Peachy-Kountz, in order to provide optimized product availability information (Peachy-Kountz, col. 4, lines 11-12).

Cameron, on the other hand, teaches the customer is allowed to view the images of the item (col. 89, lines 36-38; col. 89, lines 60-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program, and system of Publicover to include, the customer is allowed to view the images of the item, as taught by Cameron, in order to display an electronic image depicting a representation of the item (col. 89, lines 60-64).

Regarding claims 34-35, Publicover discloses a computer-implemented method comprising: for effecting via a computer network (Figure 1; paragraphs 25 and 75), substitutions of at least one ordered item of at least one customer order, the method comprising: receiving, via a computer network (paragraphs 75-76) at least one customer order (customer places an order), the at least one customer order including more than

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one ordered item placed by a customer through a computing device (one or more items; paragraph 7), the customer order being a current order of the customer, including delivery time information regarding the order (paragraph 75); upon determining that at least one item has been oversold, automatically modifying at least a portion of the received customer orders by substituting alternate merchandise for ordered merchandise, where the substitution of merchandise items implemented by using information regarding at least one substitution preference stored in a storage medium, the at least one substitution preference being provided by the customer (paragraphs 75-76); fulfilling the modified customer orders (paragraphs 75-77); wherein the customer is allowed to modify the at least one substitution preference during the current order (paragraph 76); and the substitution is performed automatically, without intervention by a human (paragraph 9; paragraph 75).

However, Publicover does not explicitly disclose the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory; aggregating a selected portion of the plurality of customer orders; and analyzing the plurality of ordered items, which includes at least one ordered item, to determine whether at least one items of merchandise has been oversold; and the customer is allowed to view the images of the item. Publicover discloses goods in an ordered basket, which are in different product groups within the ordered basket, may arrive at different times (paragraph 77). Furthermore, Publicover discloses substitution of an out of stock product may be predetermined or system may be preprogrammed to digitally contact customer with several choices based on a customer profile (paragraph 75). The

individual customer may input information detailing their preferences on product substitution in case of unavailability (paragraph 76).

Peachey-Kountz, on the other hand, teaches an ATP (available-to -promise) engine tool and system that automatically makes substitutions based on business decisions, rules and in user-defined information (col. 10, lines 4-7). The business rules, which include customer requirements and enterprise, order commitment policies determine solutions without manual intervention (col. 12, lines 26-32). The Peachy-Kountz teaches the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory (col. 4, lines 45-67); aggregating a selected portion of the plurality of customer orders (col. 3, lines 52-56; col. 3, lines 61-67; col. 5, lines 37-44; col. 7, lines 6-16; col. 10, lines 24-31); and analyzing the plurality of ordered items, which includes at least one ordered item, to determine whether at least one items of merchandise has been oversold (col. 3, lines 52-56; col. 3, lines 61-67; col. 5, lines 37-44; col. 7, lines 6-16; col. 10, lines 24-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method of Publicover, to include the at least one ordered item relating to an ordered quantity larger than one of a particular item of inventory; and aggregating a selected portion of the plurality of customer orders; and analyzing the plurality of ordered items, as taught by Peachy-Kountz, in order to provide optimized product availability information (Peachy-Kountz, col. 4, lines 11-12).

Cameron, on the other hand, teaches the customer is allowed to view the images of the item (col. 89, lines 36-38; col. 89, lines 60-64).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the method, program, and system of Publicover to include, the customer is allowed to view the images of the item, as taught by Cameron, in order to display an electronic image depicting a representation of the item (col. 89, lines 60-64).

Regarding claims 37-39, Publicover discloses the substitution preference is a general substitution preference of the customer; is a specific substitution preference of the customer; and is previously provided by the customer before the current order (paragraphs 75-76).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-32, 34-35, and 37-39 have been considered but are moot in view of the new ground(s) of rejection.

Applicants' remark that in Peachey "there is no teaching or suggestions of applying the system to on-line shopping". Furthermore, Applicants' remark that "nonanalogous art cannot be used to establish obviousness". Moreover, Applicants' remark that "the Office Action was attempting to do, picking and choosing among isolated disclosures in the prior art to deprecate the claimed invention, based on hindsight".

In response to applicant's argument that "there is no teaching or suggestions of applying the system to on-line shopping", a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the

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prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

In response to applicant's argument that Peachey is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Peachey discloses a system that receives order from multiple demand sources or ordering systems (abstract). Peachy further discloses an online server system which interfaces directly to the order-entry system (col. 6, lines 63-64). Peachey teaches automatically makes substitutions based on business decisions, rules and in user-defined information (col. 10, lines 4-7). The business rules, which include customer requirements and enterprise, order commitment policies determine solutions without manual intervention (col. 12, lines 26-32). The present invention teaches a method for effecting substitution of at least one ordered item of at least one customer order by analyzing a selected portion of the received customer order.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

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reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants' remark that "Peachey does not teach or keeping any record of the customer's substitution preference by having it stored, or allowing the customer to modify the preference during the order, let alone deciding what to substitution based on information regarding the customer's substitution preference".

The Examiner draws Applicants' attention to the Office Action above.

Applicants' remark that "Peachey does not teach or suggest allowing a customer to view the image of a product through a computing device".

The Examiner draws Applicants' attention to the Office Action above.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot  
June 7, 2006



STEVE B. MCALLISTER  
PRIMARY EXAMINER